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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,535

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Mauro Gelli

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BREINER & BREINER, L.L.C.  
P.O. BOX 320160  
ALEXANDRIA, VA 22320-0160

EXAMINER

ALVAREZ, MARITZA N

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,535	<b>Applicant(s)</b> GELLI ET AL.	
	<b>Examiner</b> MARITZA ALVAREZ	<b>Art Unit</b> 4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006 (Prelim. Amend.).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-60 is/are pending in the application.
- 4a) Of the above claim(s) 61-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060217</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.
  - a. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
  - b. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
2. Group I, claim(s) 39-60, drawn to a sheet of paper material.
3. Group II, claim(s) 61-80, drawn to a method to produce a web.
4. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I and group II share the common and/or corresponding technical features of a sheet of paper material as claimed in claim 39 because the method of claim 61 that makes the material of claim 39.
5. However, in order to be considered a common special technical feature, the subject matter of claim 39 must be novel and non-obvious. The above described technical features are not novel and non-obvious. Hauke, WO03/043812 A, discloses a paper towel material comprising at least a first ply and a second ply. At least one of the ply is provided with and embossing and at least one layer is provided with printing (see

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page 1, paragraph 0001) (citations are to US Pub. 2004/0028935 A1, a translation of WO 03/043812). Additionally, the layers can be cemented to each other by means of glue (see page 1, paragraph 009). By a suitable combination of the print image and the pattern of the embossing or the orientation of the print image and the embossed pattern to one another, an optical impression can ultimately be engendered which is similar to the appearance of a fabric (see page 1, paragraph 0005). Hauke fulfills the limitations of claim 1, although a decorative pattern that has shading is not explicitly mentioned, Hauke discloses that the print on the paper towel can have the most varied patterns and combination of patterns (see page 1, paragraph 007). Additionally, obviousness is supported by section 2144.04 of the MPEP which cites *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) where the court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

6. During a telephone conversation with Ms. Mary Breiner on 7/28/2009 a provisional election was made with traverse to prosecute the invention of a sheet of paper material, claims 39-60. Affirmation of this election must be made by applicant in replying to this Office action. Claims 61-80 are withdrawn from further consideration by the examiner, 37 CFR 1.142 (b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

7. A person shall be entitled to a patent unless –

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8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 39 -43, 47-51, and 56-59 are rejected under 35 U.S.C. 102(b) as anticipated by Hauke (WO03/043812 A1) (US Pub. 2004/0028935 A1 is the translation of WO 03/043812).

10. Regarding claim 39, Hauke discloses a paper towel material comprising at least a first ply and a second ply. At least one of the ply is provided with an embossing and at least one layer is provided with printing (see page 1, paragraph 0001). Additionally, the layers can be cemented to each other by means of glue (see page 1, paragraph 0009). By a suitable combination of the print image and the pattern of the embossing or the orientation of the print image and the embossed pattern to one another, an optical impression can ultimately be engendered (see page 1, paragraph 0005). Hauke fulfills the limitations of claim 1, although a decorative pattern that has shading is not explicitly mentioned, Hauke discloses that the print on the paper towel can have the most varied patterns and combination of patterns (see page 1, paragraph 0007).

11. Regarding claim 40, Hauke shows in fig 3 and 4 that the alignment is inclined with respect to a longitudinal edge of the claimed material.

12. Regarding claims 41 and 43, Hauke shows in fig 7 an outer layer which is embossed in a straight line shape (see page 3, paragraph 0042). Additionally, Hauke discloses that the embossing pattern may have different variations not only in the geometrical or figured patterns but also in their orientation (see page 2, paragraph 0023)

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13. Regarding claim 42, Hauke shows in fig 5 an outer layer which is embossed in a strip shape (see page 3, paragraph 0041).

14. Regarding claims 47, 49, 50, and 51, Hauke shows in its Fig 1 a three ply paper towel, which consists of a middle layer 2 and a first outer layer 3 and a second outer layer 4. The layers 2, 3 and 4 are joined using a colored binder (see page 2, paragraph 0030). Fig 1 shows a second embossed layer, layer 4, which is essentially continuous lines, and is constituted by alignments parallel with one another, and inclined with respect to said longitudinal edge, of essentially geometrical protuberances, and substantially the alignments have the same pitch of the lines of the first embossing.

15. Regarding claim 48, Hauke discloses that it is possible to carry out embossing on the bottom outer layer 4, both in terms of the patterns and also of the orientation differently than the embossing on the outer layer 3 (see page 3, paragraph 0039).

16. Regarding claim 56, Hauke discloses the layers 2, 3 and 4 are joined using a colored binder (see page 2, paragraph 0030).

17. Regarding claim 57, Hauke discloses the embodiment in fig 3 shows the colors and the transparency of the print 5 and the binder 9 can be matched to one another such that for example the areas 10 and 13 in fig 3 and 4 (see page 2, paragraph 0035).

18. Regarding claim 58, Hauke teaches that in its fig.4 the print 5 and glue 9 have different colors (see page 2, paragraph 0033).

19. Regarding claim 59, Hauke teaches in its fig 4 that the print 5 and glue 9 have different colors and explains that due to the superposition of the inner layer 2 and the outer layer 3 there are different areas, such as area 11 where the middle layer 2 is

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printed and the print 5 is being superimposed by the colored binder 9 of an elevated area 7 (see page 2, paragraph 0034). The area 11 can stand out more or less dramatically since the colors of the print 5 and the binder 9 can be different (see page 2, paragraph 0036). Hauke does not explicitly point out if the colors are primary or not; however, the effect should be the same as being primary or not.

20. Regarding claim 60, Hauke disclosed that in a triple layer embodiment is preferably the two outer layer are provide with embossing to achieve the optical elect on both sides of the paper towel (page 1, paragraph 0013); however, Hauke does not limit is invention to this embossing composition and expand its teaching when said that the image furthermore dependent on whether the print is applied to an embossed or unembossed layer (see page 1, paragraph 0015).

### ***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

22. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- c. Determining the scope and contents of the prior art.
- d. Ascertaining the differences between the prior art and the claims at issue.
- e. Resolving the level of ordinary skill in the pertinent art.
- f. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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24. Claims 39 -43, 47-51, and 56-59 are rejected under 35 U.S.C. 103(a) as been obvious over Hauke (WO03/043812 A1) (US Pub. 2004/0028935 A1 is the translation of WO 03/043812). In case the claims are not considered anticipated by Hauke.

25. Regarding claim 39, Hauke discloses a paper towel material comprising at least a first ply and a second ply. At least one of the ply is provided with an embossing and at least one layer is provided with printing (see page 1, paragraph 0001). Additionally, the layers can be cemented to each other by means of glue (see page 1, paragraph 0009). By a suitable combination of the print image and the pattern of the embossing or the orientation of the print image and the embossed pattern to one another, an optical impression can ultimately be engendered (see page 1, paragraph 0005). Hauke fulfills the limitations of claim 1, although a decorative pattern that has shading is not explicitly mentioned, Hauke discloses that the print on the paper towel can have the most varied patterns and combination of patterns (see page 1, paragraph 0007).

26. Regarding claim 40, Hauke shows in fig 3 and 4 that the alignment is inclined with respect to a longitudinal edge of the claimed material.

27. Regarding claims 41 and 43, Hauke shows in fig 7 an outer layer which is embossed in a straight line shape (see page 3, paragraph 0042). Additionally, Hauke discloses that the embossing pattern may have different variations not only in the geometrical or figured patterns but also in their orientation (see page 2, paragraph 0023)

28. Regarding claim 42, Hauke shows in fig 5 an outer layer which is embossed in a strip shape (see page 3, paragraph 0041).



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29. Regarding claims 47, 49, 50, and 51, Hauke shows in its Fig 1 a three ply paper towel, which consists of a middle layer 2 and a first outer layer 3 and a second outer layer 4. The layers 2, 3 and 4 are joined using a colored binder (see page 2, paragraph 0030). Fig 1 shows a second embossed layer, layer 4, which is essentially continuous lines, and is constituted by alignments parallel with one another, and inclined with respect to said longitudinal edge, of essentially geometrical protuberances, and substantially the alignments have the same pitch of the lines of the first embossing.

30. Regarding claim 48, Hauke discloses that it is possible to carry out embossing on the bottom outer layer 4, both in terms of the patterns and also of the orientation differently than the embossing on the outer layer 3 (see page 3, paragraph 0039).

31. Regarding claim 56, Hauke discloses the layers 2, 3 and 4 are joined using a colored binder (see page 2, paragraph 0030).

32. Regarding claim 57, Hauke discloses the embodiment in fig 3 shows the colors and the transparency of the print 5 and the binder 9 can be matched to one another such that for example the areas 10 and 13 in fig 3 and 4 (see page 2, paragraph 0035).

33. Regarding claim 58, Hauke teaches that in its fig.4 the print 5 and glue 9 have different colors (see page 2, paragraph 0033).

34. Regarding claim 59, Hauke teaches in its fig 4 that the print 5 and glue 9 have different colors and explains that due to the superposition of the inner layer 2 and the outer layer 3 there are different areas, such as area 11 where the middle layer 2 is printed and the print 5 is being superimposed by the colored binder 9 of an elevated area 7 (see page 2, paragraph 0034). The area 11 can stand out more or less

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dramatically since the colors of the print 5 and the binder 9 can be different (see page 2, paragraph 0036). Hauke does not explicitly point out if the colors are primary or not; however, the effect should be the same as being primary or not.

35. Regarding claim 60, Hauke disclosed that in a triple layer embodiment is preferably the two outer layer are provide with embossing to achieve the optical elect on both sides of the paper towel (page 1, paragraph 0013); however, Hauke does not limit is invention to this embossing composition and expand its teaching when said that the image furthermore dependent on whether the print is applied to an embossed or unembossed layer (see page 1, paragraph 0015).

36. Regarding all of the above claims, Hauke does not disclose explicitly that the printing has shading simulating a relief three-dimensional design. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hauke's teaching and disclosures since the tissue produce by Hauke has the characteristics claimed by the instant claims. The embossing in combination with the printing is producing a paper tissue that is aesthetic and has the textile appearance. One of ordinary skill in the art at the time of the invention would have been motivated by reasonable expectation of successfully obtain more attractive and decorative tissue that enhance its textile appearance.

37. This obviousness statement is support by MPEP section 2144.04 refers to aesthetic design changes and cites *In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947) where the court found that matters relating to ornamentation only which have no

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mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

38. Claims 44-46 are rejected under 35 U.S.C. 103 (a) as being obvious over Hauke (WO03043812 A1) in view of Batra (US Pat. 6,520,330 B1).

39. Regarding claims 44, 45, and 46, Hauke discloses a paper towel material comprising at least a first ply and a second ply. At least one of the ply is provided with and embossing and at least one layer is provided with printing (see page 1, paragraph 0001). Additionally, the layers can be cemented to each other by means of glue (see page 1, paragraph 009). By a suitable combination of the print image and the pattern of the embossing or the orientation of the print image and the embossed pattern to one another, an optical impression can ultimately be engendered (see page 1, paragraph 0005). Hauke does not disclose a decorative pattern that simulates an embossing.

40. Batra discloses a consumer products disposed in and dispensed from a package and both, package and product, have matched indicia (see column 1, lines 5-10). The indicia may 15 may be applied by printing (see column 4, lines 53-55). In reference to fig 2B, indicia 26 simulates a relief. Indicia 26 is different from indicia 22 in fig. 1 just because is shade using parallel lines. In fig 4B – 4D the relief effect is obtained drawing one heavy line and one light line (see column 7, lines 46-50). Batra provides a design of a package and product. The printing on those articles produces a relief -like sensation such sensation is achieved using shading in its indicia 26. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hauke's teaching and disclosures with Batra disclosure to obtain a tissue that would enhance the

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three dimension effect of the embossing. One of ordinary skill in the art at the time of the invention would have been motivated by reasonable expectation of successfully obtain more attractive and decorative tissue that enhance the sensation of deepness.

41. Claims 52-55 are rejected under 35 U.S.C. 103 (a) as being obvious over Hauke (WO03043812 A1) in view of Laurent et al. (US Pat. 6,106,928 B2).

42. Regarding claims 52-55, Hauke discloses a paper towel material comprising at least a first ply and a second ply. At least one of the ply is provided with and embossing and at least one layer is provided with printing (see page 1, paragraph 0001).

Additionally, the layers can be cemented to each other by means of glue (see page 1, paragraph 009). By a suitable combination of the print image and the pattern of the embossing or the orientation of the print image and the embossed pattern to one another, an optical impression can ultimately be engendered (see page 1, paragraph 0005). Hauke does not disclose the embossing width and density range.

43. Laurent discloses a sheet of paper that is characterized in that the patterns elements from first protrusion 10 constituting a line-shaped surface with a width between 0.1 – 2 mm, the second protrusion (2) being arrayed at the rate of at least 30 – 40 protrusions/  $\text{cm}^2$ , this means that there are 5 – 6 protrusions/cm (see abstract). This high density imparts a textile appearance to the sheet (see column 6, lines 31-32).

Regarding claim 55, Laurent discloses that if the pattern element 1 is defined by a closed line as shown in fig 7, then preferably there are as many alignments as allowed by the defined space. In fig 7 each pattern contains three alignments 21, 22, 23 (see column 7, lines 3-5). According to fig 7, if every alignment is considered as a line then

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there are more than 1.5 alignments/lines per cm. Additionally, if Laurent's fig 7 is compared with Hauke's fig 7, Hauke's design is more complex; however, they both share common elements such as lines and curves. As Laurent discloses the width of the element may vary in the same manner as the bold and thin strokes of calligraphy (see column 4, lines 15-17).

44. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hauke's teaching and disclosures, especially the design in fig 7 with Laurent disclosure about the spacing to form an apparent continuous line, alignments, and the relation between width and height of the different embossing in the design. One of ordinary skill in the art at the time of the invention would have been motivated by reasonable expectation of successfully obtain a tissue with a textile appearance combining Hauke and Laurent teaching and disclosures.

### ***Conclusion***

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARITZA ALVAREZ whose telephone number is (571)270-1135. The examiner can normally be reached on Monday to Thursday from 7:30 am to 5:00 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael LaVilla can be reached on 5712721539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./

MARITZA N. ALVAREZ

Patent Examiner, Art Unit 4132

July 29, 2009

**/Michael La Villa/**

**Michael La Villa**

**Supervisory Patent Examiner, Art Unit 4132**

**31 July 2009**